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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	Application No. 09/900,485	Applicant(s) CHERKAS ET AL.	
	Examiner Siegfried E. Chencinski	Art Unit 3692	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 1-26 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Wallman (US Patent 6,161,098).

#### **COMMENTS:**

a) Each tax program is focused on one tax year because the tax laws and regulations change for each tax year. This also means that, especially for "small investors", evaluations for the currently active tax year have to be done using the prior year's tax program until the Congress and the IRS have locked in the tax law and regulations for the tax year and the tax software providers have distributed the new tax software for purchase. Often this only occurs during the following January after the tax year has passed and no transactions affecting the tax year are possible. However, some known or likely revisions may be able to be simulated through adjustments in appropriate fields.

b) By definition, a tax return is confined to one tax year, so tax information is inherently related to each separate year. Thus a given tax return concerns itself with a single year. Also a tax return is synonymous with one tax year of the user. The current tax year's information is all "pro-forma" or estimated or proposed. Past year's tax information is more permanent, but is subject to revisions until the initial tax return for a given tax year is filed, but is then subject to amendments if the taxed person chooses to submit such revisions, and is also subject to later challenges and revisions by the IRS.

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**Re. Claim 1**, Wallman discloses a computer implemented method of determining the consequences of an investment transaction to a potential total tax liability of a user, the method comprising:

- storing for the user a tax profile containing tax return data for at least one tax year of the user (Database – Fig. 3; Col. 3, l. 14; Col. 6, ll. 6-12; Col. 13, ll. 19-33. The stored tax profile containing the tax return data is inherent.). The two wherein clauses are non-functional descriptive matter which do not have patentable weight since they merely describe the obvious content of a tax profile, and the obvious information that the stored information is in an accessible form. Storing in a non-accessible form would be purposeless in the context of this invention.);
- accessing the tax profile of the user to obtain tax return information relevant to determining the user's total tax liability in a current tax year (Col. 3, ll. 35-38; Col. 5, l. 65 – Col. 6, l. 12; Col. 6, ll. 13-21. The impact on the current tax year is inherent, since it is implicit that the sell/buy action decisions taught by Wallman are for the current year, especially the very near term, such as the same day, or a short period beyond that.); and
- Providing the user with a potential total future tax liability of the user based on a proposed brokerage transaction and the tax return information from the tax profile (Col. 2, ll. 63-67; Col. 3, ll. 35-38; Col. 7, ll. 20-24. The wherein clause is informational and has no patentable weight because it is non-functional descriptive material. Computing using the actual and tax data merely makes the obvious focus of the computation explicit.).

Wallman does not use the expression “total future tax liability”. However, in fact Wallman discloses the same thing in equivalent language. Wallman discloses a method and system which enables a user to determine his total potential tax liability for a given year such as the current year by enabling the user to combine all of his taxable activities, i.e. all of his sources of income, beginning with employment income, and then using his method and system to test what-if scenarios regarding his existing

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investments and prospective investments. Wallman's disclosure concerns itself with both short term (current tax year) and long term (over one year ending in the current tax year or in a future tax year) (Col. 2, ll. 49-52). Thus Wallman concerns himself with assisting the small investor individual in managing his total future tax liabilities.

Examples of his disclosure which demonstrates this are the following: a) Overall tax results, including income taxes (Col. 2, ll. 44-48; Col. 15, l. 12); b) various other taxable transactions listed in Col. 15, ll. 9-23: brokerage transactions which result in short and long term capital gains (l. 10-11), and transactions which include foreign or domestic securities, equities, options, mutual fund shares, bonds, etc. (ll. 17-18); and c) Wallman makes numerous references to the calculation of total tax liability including the several references to the coincident use of tax software such as those represented by Intuit's TurboTax (Reg) or Kiplinger's TaxCut (Reg) (Col. 6, ll. 6-12; 45-57). The suggestion of a user's total tax is clearly obvious. Further, discussion of marginal tax rates clearly evoke the total tax, since a marginal tax rate is calculated by the difference in two total tax scenarios.

Wallman does this through a "system for managing the portfolio of securities enabling the investor easily to make a selection and place an order as to the desired cash and tax results". (Col. 2, ll. 65-67).

Therefore an ordinary practitioner of the art at the time of Applicant's invention would have found it obvious to have used Wallman's disclosure in order to establish a computer implemented method of providing potential future tax liability for a user based on a proposed brokerage transaction and the tax return information from eh tax profile, motivated by a desire to offer a method and apparatus for enabling a small investor with a portfolio of securities to understand and manage the related taxable events and cash implications created by buying and selling securities in a complex portfolio (Wallman, Col. 2, ll. 55-60).

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**Re. Claim 2,** Wallman discloses:

- storing a brokerage account of the user in which the proposed brokerage transaction is to be entered (Col. 3, ll. 14-16; Col. 6, ll. 6-12. Storing is implicit); and
- linking the brokerage account of the user to the tax profile of the user for obtaining the tax return information to determine the potential total future tax liability (Col. 2, ll. 63-67; Col. 3, ll. 35-38; Col. 5, l. 65 – Col. 6, l. 5; Col. 7, ll. 20-24. The linkage is inherent.).

**Re. Claim 3**, Wallman discloses a method wherein the brokerage account is stored in a brokerage account database, and the tax profile is stored in a tax profile database that is physically separate from the brokerage account database (Col. 3, ll. 14-17; Col. 6, ll. 6-12. Separate storage of each is implicit.).

**Re. Claim 4**, Wallman discloses a method comprising:  
determining a potential total future tax liability of the user in the absence of the proposed transaction; and providing the user the potential total future tax liability from the proposed transaction in comparison with the potential total future tax liability in the absence of the proposed transaction (This is inherent in Wallman's teaching because this is at the core of Wallman's method wherein the comparison is made between the tax consequence of no action versus the tax consequences of various possible asset sale actions. Col. 6, ll. 50-66).

**Re. Claims 5 & 18**, Wallman has been discussed above. Wallman discloses providing the user with a potential total future tax liability of the user based on the proposed transaction and the tax return information from the tax profile.

Wallman also discloses or suggests

- **Re. Claim 5**, accessing prior completed transactions of the user relevant to the current tax return of the user; and determining the potential total future tax liability from the prior completed transactions, the tax return information, and the proposed transaction in Col. 6, ll. 50-57.
- **Re. Claim 18**, determining the potential total future tax liability based on the proposed transaction, the tax return information from the user's tax profile, and

previously executed transactions effecting tax liability in the current tax year (Col. 6, ll. 50-57).

Wallman discloses interacting "with a program that calculates the taxable effect of a transaction based on other taxable transactions, income and other taxable items known to the user or expected to be engaged in by the user, either as stored in a program such as Intuit's Turbo Tax ® or other wise inputted into the program by the user". Applicant only includes two references to these limitations in the disclosure, one being this claim 5, and the other being in specification section [0031] on page 7, line 11 ("previous transactions already completed"). The practitioner would have known that such transactions include prior asset sales during the current tax year, possible tax credits from prior tax year transactions, the current tax year's tax liability by the next quarterly estimated tax payment deadline and the next April 15<sup>th</sup> filing and payment deadline; and potential future tax liabilities or tax credits resulting from asset sale transactions during the current tax year. The ordinary practitioner would have understood tax regulations sufficiently to know that "prior completed transactions of the user relevant to the current tax year of the user".

**Re. Claims 5 and 18:**

It would have been obvious to an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosures of Wallman with a basic understanding of individual tax return options in order to offer an automated method for calculating potential total future tax liability based on a proposed transaction and tax return information, motivated by a desire to offer a method and apparatus for enabling a small investor with a portfolio of securities to understand and manage the related taxable events and cash implications created by buying and selling securities in a complex portfolio (Wallman, Col. 2, ll. 55-60).

**Re. Claim 6,** Wallman discloses a method wherein the stored tax profile comprises a user's tax filing status, income information, and deduction information. (Col. 6, ll. 6-12). This is inherent because a tax payer's tax filing status, income and deduction information have been standard data components of tax return information for many decades, and are data elements which impact the tax payer's tax formula.

**Re. Claim 7**, Wallman discloses a method wherein the stored tax profile comprises the user's marital status, home ownership status, and dependent information. (Col. 6, ll. 6-12). This is inherent because a tax payer's marital status, home ownership status, and dependent information have been standard data components of tax return information for many decades, and are data elements which impact the tax payer's tax formula.

**Re. Claims 8-11 & 13**, Wallman does not explicitly disclose:

**Re. Claim 8**, wherein items of tax return information in the user's tax profile are mapped to fields on computer representations of tax forms used to compute tax liability (Wallman discloses the importing of tax return information from a tax program to identify potential tax savings from engaging in a transaction involving any of the capital assets in a database. It would have been obvious to the ordinary practitioner that the user's tax profile are mapped to fields on computer representations of tax forms used to compute tax liability because that is a well known technique in the computer software utilization process).

**Re. Claim 9**, wherein the tax profile stores tax return information for a plurality of prior tax years (This is implicit and well known as a feature of standard tax programs such as those referenced in the disclosure – Col. 6, ll. 6-12).

**Re. Claim 10**, wherein the tax profile stores tax return information for alternative scenarios of the current tax year (This was obvious and well known to the ordinary practitioner at the time of Applicant's invention. Alternative scenarios have been a standard feature of tax programs prior to Applicant's invention.).

**Re. Claim 11**, wherein the tax profile stores tax return information at a plurality of levels of granularity to allow for adaptation of tax data from external data sources. (Granularity is an expression whose computer industry usage means "from coarse to fine, of a computer activity or feature in terms of the size of the units it handles (e.g. - sets of data). The larger the pieces, the coarser the granularity. Microsoft Computer Dictionary). Multiple levels of granularity to allow for adaptation of tax data from external data sources were well known elements in the database management process at the time of Applicant's invention.

**Re. Claim 13**, receiving the user's tax profile from a direct manual input by the user. However, Wallman discloses the user inputting information from his own records (Col. 3, ll. 16-17, Col. 6, ll. 15-18). It would have been obvious to the practitioner to have provided the option of permitting or enabling the user to enter the user's tax profile by a direct manual input by the user.

**Re. Claims 8-11 & 13**, it would have been obvious to an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosures of Wallman with a basic understanding of individual tax return options in order to offer an automated method for calculating potential total future tax liability based on a proposed transaction and tax return information, motivated by a desire to offer a method and apparatus for enabling a small investor with a portfolio of securities to understand and manage the related taxable events and cash implications created by buying and selling securities in a complex portfolio (Wallman, Col. 2, ll. 55-60).

**Re. Claim 12**, Wallman discloses a method wherein the tax profile stores for each investment, information from which an acquisition price, an acquisition date, a sale price, a sale date, a holding period, and a gain or loss can be computed. (Col. 4, ll. 28-33, 56-66).

**Re. Claim 14**, Wallman discloses a method importing data for the user's tax profile from file generated by a tax preparation software application (Col. 6, ll. 6-12).

**Re. Claim 15**, Wallman discloses a method responsive to the user executing the proposed transaction, updating the tax profile to reflect the proposed transaction (Col. 5, l. 65 – Col. 6, l. 5).

**Re. Claim 16**, Wallman discloses a method wherein providing future tax liability data to the user further comprises: providing an amount of the total future tax liability to the user (Col. 3, ll. 36-48).

**Re. Claim 17**, Wallman discloses a method of providing an amount of the marginal tax owed or saved from the proposed transaction (Col. 3, ll. 36-48. It is implicit in Wallman that the tax owed or saved is shown).

**Re. Claim 19**, Wallman discloses a computer implemented method of determining tax liability, the method comprising:

- storing for a user a tax profile containing tax return data for at least one tax return of the user (Database – Fig. 3; Col. 3, I. 14; Col. 6, II. 6-12; Col. 13, II. 19-33. The stored tax profile containing the tax return data is inherent. The two wherein clauses are non-functional descriptive matter which do not have patentable weight since they merely describe the obvious content of a tax profile, and the obvious information that the stored information is in an accessible form. Storing in a non-accessible form would be purposeless in the context of this invention.);
- receiving a plurality of proposed investment transactions from the user to be executed in a group (Col. 2, II. 65-67; Col. 3, II. 21-24, 35-37, 42-45);
- accessing the tax profile of the user to obtain tax return information relevant to determining the user's total tax liability in a current tax year (Col. 6, II. 6-12, 15-21, 40-49; Col. 3, II. 37-42);
- determining a potential total future tax liability of the user based on all of the proposed transactions and the tax return information from the tax profile (Col. 6, II. 40-49. The wherein clause is informational and has no patentable weight because it is non-functional descriptive material. Computing using the actual and tax data merely makes the obvious focus of the computation explicit.); and
- providing the potential total future tax liability to the user (Col. 3, II. 53-56, 65-67).

**Re. Claim 20,** Wallman discloses a computer implemented method of determining tax liability, the method comprising:

- storing for a user a tax profile containing tax return data for at least one tax return of the user (Database – Fig. 3; Col. 3, I. 14; Col. 6, II. 6-12; Col. 13, II. 19-33. The stored tax profile containing the tax return data is inherent. The two wherein clauses are non-functional descriptive matter which do not have patentable weight since they merely describe the obvious content of a tax profile, and the obvious information that the stored information is in an accessible form. Storing in a non-accessible form would be purposeless in the context of this invention.);

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- receiving a plurality of separate proposed investment transactions from the user, each investment transaction to be executed independently (Col. 2, ll. 63-67; Col. 3, ll. 23-24, 35-38, l. 59 – each potential trade, l. 66 – each asset/liability; Col. 4, ll. 12-14 – which of the securities must be sold – this must be either a single, independent transaction or a group or multiple transaction, as determined by the user . The seller's instructions necessarily include a transaction to be executed independently.);
- accessing the tax profile of the user to obtain tax return information relevant to determining the user's total tax liability in a current tax year (Col. 6, ll. 6-12, 15-21, 40-49; Col. 3, ll. 37-42);
- for each proposed investment transaction, determining a potential total future tax liability of the user based on the proposed transaction and the tax return information from the tax profile (Col. 6, ll. 50-57. The wherein clause is informational and has no patentable weight because it is non-functional descriptive material. Computing using the actual and tax data merely makes the obvious focus of the computation explicit.); and
- providing the potential total future tax liability for each proposed investment transaction to the user (Col. 3, ll. 53-56, 65-67).

**Re. Claim 21**, Wallman discloses a method of determining the proposed investment transaction that has the best overall tax consequences for the user (Col. 4, ll. 1-14; Col. 6, ll. 40-57.).

**Re. Claim 22**, Wallman discloses a system for determining a total future tax liability of a user for a proposed investment transaction, comprising:

- tax profile database adapted to store a plurality of tax profiles particularized to a plurality of users, each tax profile being stored in accessible form and including tax return information for the user (Database – Fig. 3; Col. 3, l. 14; Col. 6, ll. 6-12; Col. 13, ll. 19-33. The stored tax profile containing the tax return data is inherent. The wherein clause are non-functional descriptive matter which do not have patentable weight since they merely describe the obvious content of a tax

profile, and the obvious information that the stored information is in an accessible form. Storing in a non-accessible form would be purposeless in the context of this invention.);

- a brokerage interface adapted to receive a proposed transaction from the user (Col. 3, l. 15, 23-28; Col. 7, ll. 8-11, 41-48); and
- a tax engine adapted to receive the proposed transaction and coupled to obtain the tax return information from the tax database, and further adapted to calculate the potential future tax liability of the user based on the proposed transaction and tax return information (Col. 7, ll. 20-26; Col. 6, ll. 6-12. The wherein clause is informational and has no patentable weight because it is non-functional descriptive material. Computing using the actual and tax data merely makes the obvious focus of the computation explicit.).

**Re. Claim 23**, Wallman discloses an account database adapted to store user's brokerage accounts, each user brokerage account linked to the user's tax profile in the tax profile database (Col. 3, ll. 13-16; Col. 5, l. 65 – Col. 6, l. 5).

**Re. Claim 24** Wallman discloses a user interface for a computer system that determines tax liability, the user interface being provided by a computer program encoded on a computer media usable by the computer system, the user interface comprising:

- a first window for receiving at least one proposed investment transaction entered by a user (Col. 3, ll. 1-9. The first window is inherent – see pop-up window, Col. 7, l. 3);
- a control for executing, in response to selection by the user, a determination of a potential future tax liability of the user from the proposed transaction using tax return information of the user stored in a tax profile (Col. 3, ll. 21-28, 53-63. The control is inherent. The wherein clauses are informational and have no patentable weight because they are non-functional descriptive material – see the rejection of claim 1 above); and

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- a second window for displaying the total potential future tax liability of the user, as a consequence of the proposed transaction (Col. 4, ll. 1-9. The second window is inherent).

**Re. Claim 25 & 26:**

**Re. Claim 25,** Wallman discloses use of an interface to display:

- any capital gains or losses from the proposed transaction (Col. 4, ll. 56-65);
- any short term gains or losses from the proposed transaction (Col. 4, ll. 56-65);

Wallman does not explicitly disclose displaying:

- a total income to the user after the proposed transaction;
- a tax rate applicable to the user as a consequence of the proposed transaction; and
- the potential future tax liability of the user as a consequence of the proposed transaction.

However, Wallman discloses and/or suggests a system and interfaces which displays all the income and taxation consequences of potential and proposed asset transactions (Col. 15, ll. 5-23). All other facets related to the management of a user's total tax consequences are disclosed in Col. 6, l. 40 – Col. 7, l.6. This includes the implicit consideration of total income, both regular income from other sources and from asset trading and also from long term capital gains, potential marginal tax rates, implied resultant total tax rates using off the shelf tax programs and an “expert agent” for managing (the) tax effects ... (which) monitors the user's tax position by comparing the capital gains effects from various proposed or available transactions’ (Col. 6, ll. 58-65).

**Re. Claim 26,** Wallman discloses using a window to display:

- any capital gains or losses before the proposed transaction (Col. 4, ll. 57-65);
- any short term gains or losses before the proposed transaction (Col. 4, ll. 57-65);

Wallman does not explicitly disclose displaying:

- a total income to the user before the proposed transaction;
- a tax rate applicable to the user prior to the proposed transaction; and

- a total tax owed by the user prior to the proposed transaction.

However, Wallman suggests the display of:

- a total income to the user before the proposed transaction;
- a tax rate applicable to the user prior to the proposed transaction; and
- a total tax owed by the user prior to the proposed transaction;

because Wallman discloses and/or suggests a system and interfaces which displays all the income and taxation consequences of potential and proposed asset transactions (Col. 15, ll. 5-23). All other facets related to the management of a user's total tax consequences are disclosed in Col. 6, l. 40 – Col. 7, l. 6. This includes the implicit consideration of total income, both regular income from other sources and from asset trading and also from long term capital gains, potential marginal tax rates, implied resultant total tax rates using off the shelf tax programs and an “expert agent” for managing (the) tax effects ... (which) monitors the user's tax position by comparing the capital gains effects from various proposed or available transactions’ (Col. 6, ll. 58-65).

**In conclusion, Re. Claim 25 & 26:** It would have been obvious to an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosures of Wallman with a basic understanding of individual tax return options in order to offer an automated method for calculating potential total future tax liability based on a proposed transaction and tax return information, motivated by a desire to offer a method and apparatus for enabling a small investor with a portfolio of securities to understand and manage the related taxable events and cash implications created by buying and selling securities in a complex portfolio (Wallman, Col. 2, ll. 55-60).

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-26 received on September 19, 2007 have been fully considered but they are not persuasive.

### **OVERVIEW of ARGUMENTS:**

1. Applicant repeats his basic argument presented in his remarks received on April 5, 2007, namely that the examiner has failed to establish a *prima facie* case of obviousness in the rejections of claims 1-26 as these claims were constituted in the amendments submitted on April 5, 2007 (p. 9, ll. 4-14).
2. Applicant's amendments submitted on September 19, 2007 do not change the substance of the previously presented claim limitations of April 5, 2007 because the content of the amended language are additions which constitute non-functional descriptive language, As stated above in the rejections of the claims.
3. Applicant states that "If the Examiner does not produce a *prima facie* case, Applicants are under no obligation to submit evidence of non-obviousness. The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicants from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention. See, MPEP §2142". Applicant's rationale appears to be based on the assumption that, by merely by declaring that the examiner has failed to establish a *prima facie* case of obviousness, Applicant is relieved of his obligation to present evidence and rationale to overcome the examiner's case of *prima facie* obviousness.
4. Applicants repeat their prior principal argument that Wallman does not teach or suggest calculating "a user's overall tax scenario" (p. 11, ll. 1-12).
5. Applicants argue that Wallman fails to teach or suggest "the combining and storing of such robust tax data in an accessible form" (p. 11, l. 13 – p. 12, l. 2).

**RESPONSE:**

1. Applicants are referred to the response to arguments presented in the Office Action mailed on June 20, 2007 which contained the examiner's response to Applicants' argument regarding the *prima facie* case of obviousness.  
Applicants are also informed of the following court opinions regarding the responsibilities of the examiner in the construction of a *prima facie* case of obviousness and Applicant's responsibility once such a case of *prima facie* obviousness has been presented by the examiner:

(a) The Board of Patent Appeals and Interferences' interpretation of the 2007 ruling by the US Supreme Court in the case known as KSR:

BPAI, *Ex parte* CATAN, Appeal 2007-0820, Decided: July 3, 2007

#### PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court in *Graham* further noted that evidence of secondary considerations, such as commercial success, long felt but unsolved needs, failure of others, etc., "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 18, 148 USPQ at 467.

In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, 82 USPQ2d at 1395, and discussed circumstances in which  
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a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test.

In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12, 148 USPQ 459, 464 (1966) (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a

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person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*Id.* at 1740, 82 USPQ2d at 1396. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Supreme Court made clear that “[f]ollowing these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement.” *Id.* The Court explained, “[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* at 1740-41, 82 USPQ2d at 1396. The Court noted that “[t]o facilitate review, this analysis should be made explicit. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741, 82 USPQ2d at 1396.

(b) The court opinion regarding Applicant's responsibilities once the examiner has presented a case of *prima facie* obviousness:

Obviousness rejection basically involves the examiner's informed and considered judgement. As such, once the examiner makes the *prima facie* case, the burden of proof falls to the Applicant to disprove the examiner's judgement. The MPEP states the following: “[T]he PTO can require an applicant to prove that the prior art products do not

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necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)). As such, the burden of proof is on Applicant to disprove the prima facie case of obviousness made by the examiner in this case.

(c) In the instant case, the examiner has presented evidence combined with rationale in the rejection of the claims in the presentation of a case of prima facie obviousness in rejecting independent claims 1, 19, 20, 22 and 24. These rejections are in compliance with the above stated case law guidance, are therefore properly presented cases of prima facie obviousness rejections. The burden of proof therefore has been and is on Applicants to present adequate evidence and rationale to overcome the prima facie obviousness rejection cases presented by the examiner.

### **Conclusion**

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Alexander Kalinowski, can be reached on (571) 272-6771.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks, Washington D.C. 20231*


or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

November 26, 2007

  
NARAYANSWAMY SUBRAMANIAN  
PRIMARY EXAMINER